

REMARKS

Summary of Office Action

Claims 1-32 are pending in this application.

The Examiner rejected claims 1, 4, 6, 8-10, 22, 25-29 and 30-31 under 35 U.S.C. § 102(b) as being anticipated by Hornback International Publication No. PCT WO 99/56463 (hereinafter, "Hornback").

Claims 2-3 and 23-24 were rejected by the Examiner under 35 U.S.C. § 103(a) as being unpatentable over Hornback in view of Rowland et al. U.S. Patent No. 5,801,970 (hereinafter, "Rowland").

Claims 11-18 were rejected by the Examiner under 35 U.S.C. § 103(a) as being unpatentable over Hornback in view of Ohta et al. U.S. Patent No. 6,577,760 (hereinafter, "Ohta").

The Examiner also rejected claims 5 and 32 under 35 U.S.C. § 103(a) as being unpatentable over Hornback in view of Eisele et al. U.S. Patent No. 6,089,459 (hereinafter, "Eisele").

Claim 7 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Hornback in view of Akins et al. U.S. Patent No. 5,623,280 (hereinafter, "Akins").

Claim 19 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Hornback in view of Miki U.S. Patent No. 6,393,745 (hereinafter, "Miki").

The Examiner rejected claims 20-21 under 35 U.S.C. § 103(a) as being unpatentable over the combination of Hornback, Miki and Rowland.

Summary of Applicant's Response

Independent claims 1, 11, 19, 22 and 30 have been amended by applicant in order to more particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Applicant has also amended the specification and claim 19 to correct newly found typographical and other non-substantive type errors. No new matter has been added by any of these amendments.

The Examiner's rejections are respectfully traversed.

Reconsideration of this application in light of the following remarks is respectfully requested.

Introduction

Applicant's claimed invention relates to a highly portable electronic photo album. A photo album according to the principles of the present invention fits inside of a pocket-sized wallet, thus enabling a user to easily carry and display multiple digital photographic images. For example, FIG. 4 shows an illustrative embodiment of the claimed invention in which a pocket-sized wallet 400 includes an electronic photo album, or photocard 100.

Moreover, as explained in applicant's Detailed Description of the Drawings, photocard 100 is "sized on the order of a credit card, or other like device" (specification, page 7, lines 15-16). The relatively small size of photocard 100 is further demonstrated by applicant's statement that the display 104 of photocard 100 "should be resilient enough that it can withstand the stress typically associated with being in a wallet, such as, for example, being sat on for an entire day" (specification, page 7, lines 26-29, as amended). Given this statement, it should be apparent that a "wallet," as defined by applicant, is small enough to be stored inside a pocket (e.g., a pants back pocket).

Accordingly, applicant respectfully submits that the Examiner has apparently misinterpreted the meaning of the term

"wallet" as used by applicant. In particular, applicant respectfully submits that the specification as filed limited the term "wallet" such that its definition is not as broad as the Examiner's suggested definition of "a bag for carrying miscellaneous articles while traveling" (see Merriam Webster's Collegiate Dictionary, 10th Edition ("the Dictionary")).

It is well settled that applicant "may be his or her own lexicographer as long as the meaning assigned to the term is not repugnant to the term's well known usage" and the meaning of the term is "sufficiently clear in the specification" (see Manual of Patent Examining Procedure, 8th edition, page 2100-48). Both of these conditions are met in the present application.

As stated above, the originally filed specification and figures clearly show applicant's intended definition of wallet as being something that is commonly placed in one's pocket. Moreover, applicant's limited definition of "wallet" is "not repugnant to the term's well known usage" because the term "wallet" is also defined by the Dictionary as "a folding pocketbook" or "billfold." In addition, the American Heritage Dictionary of the English Language, Third Edition, defines "wallet" as a "flat pocket-sized folding case, usually made of leather, for holding paper money, cards or photographs."

Nevertheless, in order to more particularly point out and distinctly claim the subject matter which applicant regards as the invention, applicant has amended independent claims 1, 11, 19, 22 and 30 to include the limitation "pocket-sized" in connection with the claimed "wallet." In responding to the rejections set forth by the Examiner below, applicant will rely on the meaning of "wallet" in light of these amendments (and applicant's originally filed specification).

Applicant's Response to the
Rejection Under 35 U.S.C. § 102(b)

Claims 1, 4, 6, 8-10, 22, 25-29 and 30-31 were rejected by the Examiner under 35 U.S.C. § 102(b) as being anticipated by Hornback.

The Examiner's rejection is respectfully traversed.

Applicant's claimed invention includes a portable electronic photo album that fits inside of a pocket-sized wallet that includes an electronic display, memory and dedicated processing circuitry for displaying one or more digital images stored in the memory (see claims 1, 22 and 30). Additionally, for example, each of these components are located within a single housing (see claims 1 and 30). Contrary to the Examiner's suggestion, Hornback fails to teach or suggest several features of the claimed invention.

First, applicant respectfully submits that, unlike the claimed invention, Hornback's electronic photo album 130 is not capable of fitting within a pocket-sized wallet, or within a housing that fits within such a wallet (see amended independent claims 1, 22 and 30). For example, while FIGS. 3A-3F of Hornback show an electronic photo album 130 that may be small enough for a person to carry from one place to another place, it is clear that photo album 130 is not small enough to fit inside of a pocket-sized wallet (see especially FIG. 3a, which provides a good comparison between the size of Hornback's photo album 130 and the size of a pair of human hands).

Moreover, the Examiner's citation of Hornback is further evidence that Hornback does not anticipate applicant's claimed invention. In particular, Hornback states on page 4, lines 14-16, that "[i]n one embodiment, the memory book is very small, on the order of the size of a large paperback novel that can hold thousands of images" (emphasis added). Thus, even in the smallest conceived embodiment, Hornback's photo album is so large that is cannot reasonably be placed in one's pocket. As such, Hornback cannot anticipate applicant's claimed invention (in fact, the thickness of Hornback's electronic film cartridge 100 shown in FIGS. 1, 2, 3A and 3F

is likely greater than that of applicant's entire electronic photo album).

In addition to rendering the claimed invention patentable as being structurally different from Hornback, this size distinction also signifies a fundamental difference between the objective of Hornback and the principles of the present invention. For example, applicant's claimed electronic photo album uses dedicated processing circuitry which simply displays one or more images located in memory. As explained in greater detail below, this permits the claimed photo album to be less expensive as well as less complex (thus achieving an extremely high level of portability, such as being able to fit in a wallet that can then be carried around inside a pocket).

Hornback, on the other hand, is concerned with providing a much higher level of functionality than the claimed invention, with the result being a larger and more costly device. For example, Hornback's photo album "can be used to transport thousands of digital images and to display those digital images in different forms for different users" (Hornback, page 2, lines 16-18, emphasis added). The integration of a built-in modem and phone jack into the photo album, for example, is also contemplated in some embodiments

of Hornback (see Hornback, page 6, line 21). Therefore, the objective and design of Hornback are clearly much different than those of the present invention.

Second, applicant respectfully submits that Hornback does not teach or suggest a housing, or housing structure, as claimed by applicant (see claims 1 and 30). In particular, applicant's claimed housing encloses an electronic display, memory and dedicated processing circuitry. Among the characteristics of such a housing, moreover, is to be "rigid enough to protect display 104" (specification, page 7, lines 20-21). Hornback, on the other hand, does not teach or suggest using a housing that encloses each of the components listed above, or that protects, for example, display 200 of photo album 130.

Third, Hornback's central processing unit (CPU) 420 (depicted in FIG. 4 of Hornback) is not the same as applicant's claimed "dedicated processing circuitry" (see claims 1, 22 and 30). As explained above, applicant's claimed invention is concerned with a high level of portability, and is able to fit within a pocket-sized wallet. This is made possible, in part, because the dedicated processing circuitry of the present invention "simply moves data in to and out of memory." The CPU 420 of Hornback, on the other hand, is used

to "compress and store images" (Hornback, page 3, line 11), for optionally "editing the images" (Hornback, page 4, line 9) as well as to perform "edge detection, gamma correction, and other image processing to enhance the appearance of the image when displayed" (Hornback, page 12, lines 16-17). Therefore, CPU 420 is not the same as the claimed dedicated processing circuitry. Rather, as a result of the added functionality, CPU 420 of Hornback's photo album 130 is necessarily more expensive and larger than applicant's claimed dedicated processing circuitry.

For at least the above reasons, applicant's independent claims 1, 22 and 30, as amended, are not anticipated by Hornback. Applicant therefore respectfully requests that the rejection of claims 1, 22 and 30, as well as claims 4, 6, 8-10, 25-29 and 31 which from one of claims 1, 22 and 30, be withdrawn.

Applicant's Response to the Rejections Under 35 U.S.C. § 103(b)

The Examiner rejected claims 2-3, 5, 7, 11-21, 23-24 and 32 under 35 U.S.C. § 103(a) as being unpatentable over some combination of Akins, Eisele, Hornback, Miki, Ohta and Rowland.

Applicant respectfully traverses the rejections of the claims under this section.

Claims 2-3 and 23-24

The Examiner rejected claims 2-3 and 23-24 under 35 U.S.C. § 103(a) as being unpatentable over Hornback in view of Rowland.

The Examiner's rejection is respectfully traversed.

Applicant respectfully submits that the Examiner's rejection is an admission that Hornback does not disclose the use of an application specific integrated circuit (ASIC) or a programmable logic device (PLD). Moreover, the rejection is also an admission that the mere use of CPU 420 by Hornback does not render obvious the use of an ASIC or PLD (if it did, the Examiner would not have relied on Rowland in making the rejection under this section, but rather would have relied on Hornback alone and what was generally known in the art at the time the present invention was made).

Moreover, while applicant agrees with the Examiner that disclosing a CPU is not the same as disclosing an ASIC or PLD, applicant disagrees with the Examiner's statement that "it would have been obvious ... to use either an ASIC or a programmable logic array (device) in place of the CPU of

Hornback's invention since these are equivalent substitutes and this is well known in the art as taught by Rowland et al." (Office Action, page 5, lines 20-23, emphasis added). First, applicant points out that Rowland does not teach or even relate to an electronic photo album as does Hornback and the claimed invention. Accordingly, one skilled in the art would at the time the present invention was made would have had no reason to look for the teachings of Rowland in order to improve upon Hornback.

Second, neither an ASIC nor a PLD is an "equivalent substitute" for a CPU for at least the reasons explained above (for example, try replacing the Pentium CPU in a computer with any ASIC or PLD -- it will not work; thus, they are not equivalent substitutes), and applicant respectfully submits that the Examiner's rejection under this section fails for the reason that the cited prior art lacks the requisite suggestion or motivation to make the combination of Hornback and Rowland set forth by the Examiner. MPEP, page 700-31 ("there must be some suggestion or motivation ... to modify the reference or to combine reference teachings). In fact, the only motivation to make the combination suggested by the Examiner comes from applicant's own specification. However, "[i]t is impermissible to use the claimed invention as an instruction

manual or 'template' to piece together the teachings of the prior art so that the claimed invention is rendered obvious." In re Fritch, 972 F.2d 1260, 1266, 23 USPQ2d, 1780, 1784 (Fed. Cir. 1992); In re Dembiczak, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999) ("[c]ombining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the inventor's disclosure as a blueprint for piecing together the prior art to defeat patentability - the essence of hindsight").

Moreover, applicant respectfully submits that even if the combination of Hornback and Rowland was proper, although it is not for at least the reasons stated above, the combination does not provide applicant's claimed invention (see the explanation above concerning the reasons why Hornback fails to anticipate the invention defined by independent claims 1 and 22).

For at least the foregoing reasons, applicant respectfully requests that the Examiner withdraw the rejection of claims 2-3 and 23-24.

Claims 11-18

Claims 11-18 were rejected by the Examiner under 35 U.S.C. § 103(a) as being unpatentable over Hornback in view of Ohta.

The Examiner's rejection is respectfully traversed.

For at least the reasons set forth above in connection with the rejection of claim 1, applicant respectfully disagrees with the Examiner contention that Hornback discloses the invention defined by independent claim 11 except that Hornback "does not specifically state that the computer can receive the captured images from the image capture means and sends the images to the photo album for storage in memory" (Office Action, page 6, lines 10-12).

For example, the claimed photo album includes "an electronic display, memory and dedicated processing circuitry" all located in a housing "that fits within a pocket-sized wallet." Hornback's photo album, however, is incapable of fitting within a pocket-sized wallet, and does not include a housing or dedicated processing circuitry as claimed by applicant. The addition Ohta does not change this, and thus, independent claim 11 is allowable. Claims 12-18, which depend from claim 11, are allowable for at least the same reasons.

Claims 5 and 32

The Examiner also rejected claims 5 and 32 under 35 U.S.C. § 103(a) as being unpatentable over Hornback in view of Eisele.

The Examiner's rejection is respectfully traversed.

For at least the foregoing reasons, Hornback does not teach or suggest each of the elements of independent claims 1 and 30 as amended. Furthermore, applicant respectfully submits that the addition of Eisele does not change this. In particular, even if Eisele teaches "an optional touch screen" (Office Action, page 8, line 3) or "a device for displaying graphical data directly from a smart diskette that may include a flash card" (Office Action, page 8, lines 13-14) that can be combined with the teachings of Hornback, the combination still does not teach or suggest applicant's claimed housing, dedicated processing circuitry, or photo album that is capable of fitting within a pocket-sized wallet, as claimed by applicant (and as discussed above with respect to the rejection under 35 U.S.C. § 102(b)).

For at least these reasons, applicant respectfully requests that the rejection of claims 5 and 32, which depend from allowable independent claims 1 and 30, respectively, be withdrawn.

Claim 7

Claim 7 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Hornback in view of Akins.

The rejection is respectfully traversed.

While admitting that Hornback fails to disclose a liquid crystal display that is substantially flexible, the Examiner stated that "it would have been obvious to one of ordinary skill in the art at the time the invention was made to configure the LCD in Hornback to be flexible since they would be less susceptible to damage, and would make the device lighter and more compact as taught by Akins et al." (Office Action, page 9, lines 10-13). Applicant respectfully disagrees with the Examiner's assertion.

As explained above, Hornback's photo album is not designed to have the same level of portability as the claimed invention. For example, unlike the claimed invention, Hornback's photo album is not capable of fitting within a pocket-sized wallet (e.g., such that it would need to be able to withstand the pressure of being sat on). Additionally, a flexible LCD would likely not provide any benefit given the amount of circuitry located internal to Hornback's photo album (see, for example, FIG. 3C of Hornback). Therefore, applicant respectfully submits that there is no reason to modify

Hornback as suggested by the Examiner, and that the present rejection is based on impermissible hindsight reconstruction because the requisite motivation is lacking from the Examiner's combination of Hornback and Akins. In re Dembiczak, 175 F.3d 994, USPQ2d 1614, 1617 (Fed. Cir. 1999) ("[c]ombining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the inventor's disclosure as a blueprint for piecing together the prior art to defeat patentability -- the essence of hindsight"); ACS Hosp. Sys. Inc. v. Montefiore Hosp., 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1994) ("the test for obviousness requires that the references, not the Examiner, provide teaching or suggestion supporting the combination of references offered").

Moreover, applicant respectfully maintains the position that Hornback does not teach each of the elements of applicant's independent claim 1. Therefore, claim 7 is also allowable because it depends from allowable independent claim 1.

For at least the above reasons, applicant respectfully requests that the rejection of claim 7 be withdrawn.

Claim 19

Claim 19 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Hornback in view of Miki.

The Examiner's rejection of claim 19 under 35 U.S.C. § 103(a) is respectfully traversed.

In rejecting claim 19, the Examiner stated that "it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Hornback's device using Miki to provide a wallet as claimed by the applicant in claim 19 since this would give the user of the electronic photo album a more secure [sic] with added versatility" (Office Action, page 10, lines 13-17). Applicant disagrees with the Examiner's contention for at least the following reasons.

First, applicant respectfully points out that Miki seeks to provide a display media back pack, and does not disclose the use of a pock-sized wallet (or any comparable object), whether for safe keeping of an electronic device or any other purpose. In fact, the term "wallet" is never even used by Miki. Therefore, Hornback and Miki, alone or in combination, simply does not "teach or suggest all the claim limitations" (emphasis added) as required to establish a *prima*

facie case of obviousness (see Manual of Patent Examining Procedure, 8th ed., page 2100-121).

Second, even if Miki did teach or suggest the use of an object similar to applicant's claimed pocket-sized wallet, although it does not, the combination of Hornback and Miki still would not provide applicant's claimed invention. As explained above, Hornback's photo album is too large to be capable of fitting within a pocket-sized wallet (or any other pocket-sized holder). Therefore, regardless of the teachings of Miki (or any other prior art document that may disclose a pocket-sized wallet), Hornback's photo album could not be used in an electronic photo album wallet as claimed by applicant.

Third, Hornback's photo album is different from the claimed photo album for reasons other than being incapable of fitting inside a pocket-sized wallet. For example, as explained above, Hornback does not teach or suggest the claimed housing or dedicated processing circuitry.

For at least the above reasons, applicant respectfully submits that independent claim 19, as amended, is allowable over the combination of Hornback and Mike. Applicant therefore requests that the rejection of claim 19 be withdrawn.

Claims 20-21

The Examiner rejected claims 20-21 under 35 U.S.C. § 103(a) as being unpatentable over the combination of Hornback, Miki and Rowland.

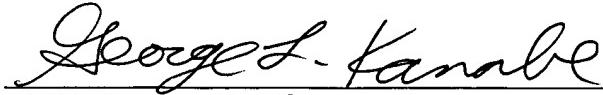
Applicant respectfully traverses the Examiner's rejection of claims 20-21.

For at least the reasons provided above, claim 19 is allowable over prior art cited by the Examiner. Accordingly, applicant respectfully requests that the rejection of claims 20-21, which depend from claim 19, be withdrawn by the Examiner.

Conclusion

In light of the foregoing, applicant respectfully submits that this application, including each of claims 1-32, is in condition for allowance. Reconsideration and a favorable action are respectfully requested.

Respectfully submitted,



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